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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,083	04/14/2004	Mikhail M. Feldstein	2335-0010	7175
23980	7590	12/28/2005	EXAMINER	
REED INTELLECTUAL PROPERTY LAW GROUP 1400 PAGE MILL ROAD PALO ALTO, CA 94304-1124			CHEUNG, WILLIAM K	
			ART UNIT	PAPER NUMBER
			1713	
DATE MAILED: 12/28/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/825,083

Applicant(s)

FELDSTEIN ET AL.

Examiner

William K. Cheung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 24-30,38-40 and 91 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-30,38-40 and 91 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

1. In view of amendment filed November 7, 2005, claims 1-23, 31-37, 42-90 have been cancelled, and new claim 91 has been added. The examiner appreciates applicants for pointing out the typographical errors relating to the restricted claims. Claims 24-30, 38-40, 91 are pending. Claims 24-30, 38-40, 91 are examined with merit.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting

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directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 24, 27, 28, 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Parker et al. (US 2003/0055190 A1) for the reasons adequately set forth from paragraph 5 of non-final office of May 31, 2005.

Applicant's arguments filed November 7, 2005 have been fully considered but they are not persuasive. Applicants argue that the polymer of Parker et al. is not hydrophilic because Parker et al. disclose the polymer as a "wax". However, applicants fail to recognize that the recited "wax" does not necessarily impart "hydrophobicity" to the disclosed polymer. "wax" is merely a term for denoting the state of the polymer at a specific temperature. Regarding the claimed "hydrophilic side chain", applicants must recognize that the structure (I) of Parker et al. can have  $R_2$  equate to H. In which, when  $R_2$  equate to H, the polymer of Parker et al. possesses a polyethylene oxide hydrophilic side chain. Applicants must also recognize that the teachings of the disclosed structure (I) broadly encompass polymers that are hydrophilic and hydrophobic, water soluble and water insoluble polymers.

Further, applicants also argue that the polymer of Parker et al. can be crosslinked. However, applicants fail to recognize that Parker et al. merely stating that the polymer maybe crosslinkable as a result of the residual unreacted groups. However,

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applicants must recognize that maybe means an occurrence that may happen or may not happen. Therefore, the examiner finds the argument filed not persuasive.

Regarding applicants' argument that Parker et al. disclose using the polymer in an emulsion or slurry that seems to indicate that the disclosed polymer is water insoluble. However, applicants must recognize that the teachings in Parker et al. is not limited just to its preferred embodiment. Since the recited structure (I) of Parker et al. clearly shows a hydrophilic side chain, the examiner has a reasonable basis to believe that the claimed "water soluble, hydrophilic" features are inherently possessed in Parker et al.

Regarding product by process claims, applicants must recognize that "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

4. Claims 24-30, 38-40, 91 are rejected under 35 U.S.C. 102(b) as being anticipated by Hart et al. (US 3,150,977) for the reasons adequately set forth from paragraph 5 of non-final office of May 31, 2005.

Applicant's arguments filed November 7, 2005 have been fully considered but they are not persuasive. Applicants argue that amended claim 38 is a copolymer comprising a comonomer having polyoxyalkylene as side chain. However, applicants must recognize that Hart et al. (col. 2, line 4-5) clearly indicate that the disclose polymer can also be a copolymer comprising vinyl monomers bearing polyoxyalkylene groups as side chains in addition to the structure of column 2, line 10. Therefore, the rejection set forth is proper.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K. Cheung whose telephone number is (571) 272-1097. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



William K. Cheung, Ph. D.

Primary Examiner

December 22, 2005

**WILLIAM K. CHEUNG**  
**PRIMARY EXAMINER**